

REMARKS

Pursuant to the present amendment, claims 1 and 14 have been amended and claims 12 and 18 have been canceled. Thus, claims 1-2, 6-8, 11, 13-15, 17, 19, 22, 24-30 and 32-37 are pending in the present application. No new matter has been introduced by way of the present amendment. Reconsideration of the present application is respectfully requested.

Claims 22, 24-30 and 33-37 stand allowed.

In the Office Action, claim 12 was rejected under 35 U.S.C. § 112. Pursuant to the present amendment, claim 12 has been canceled, thereby rendering the Examiner's rejection moot.

In the Office Action, claims 1, 6 and 11-13 were rejected under 35 U.S.C. § 102 as allegedly being anticipated by Finn (U. S. Patent No. 6,648,074). Claims 1, 12 and 13 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Finn. Claims 2 and 8 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Finn in view of Munk '182 (U.S. Patent No. 6,746,182). Claim 7 was rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Finn in view of Munk '182 and further in view of Davies (U.S. Patent No. 5,873,677). Claims 14, 15 and 17-19 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Davies in view of Grable (U.S. Patent No. 4,071,085) Applicants respectfully traverse the Examiner's rejections.

As the Examiner well knows, an anticipating reference by definition must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. *In re Bond*, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). To the extent the Examiner relies on principles of inherency in making the anticipation rejections in the Office Action, inherency

requires that the asserted proposition necessarily flow from the disclosure. *In re Oelrich*, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1463-64 (Bd. Pat. App. & Int. 1990); *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Int. 1987); *In re King*, 231 U.S.P.Q. 136, 138 (Fed. Cir. 1986). It is not enough that a reference could have, should have, or would have been used as the claimed invention. “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Oelrich*, at 326, quoting *Hansgirg v. Kemmer*, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939); *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993), quoting *Oelrich*, at 326; see also *Skinner*, at 1789. “Inherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Skinner*, at 1789, citing *Oelrich*. Where anticipation is found through inherency, the Office’s burden of establishing *prima facie* anticipation includes the burden of providing “...some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Skinner* at 1789.

Moreover, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142.

Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

Pursuant to the present amendment, claim 1 has been amended to recite that the bushing is decoupled from the keel joint by relative vertical motion between the keel joint and the keel guide. Finn is understood to be directed to a riser support and tensioning apparatus. Col. 2, ll. 28-30. The Examiner identified the item 100 in Finn as the bushing (although Finn refers to it as a sleeve). Col. 10, l. 65 – Col. 11, l. 3. Nevertheless, in view of the present amendment to claim

1, the prior art of record, including Finn, does not disclose the invention now recited in amended independent claim 1. For example, there is no suggestion in Finn that the “bushing” 100 in Finn can be decoupled from the keel joint by providing relative vertical movement between the keel guide and the keel joint, as now recited in claim 1. Accordingly, it is respectfully submitted that independent claim 1, and all claims depending therefrom, are in condition for immediate allowance.

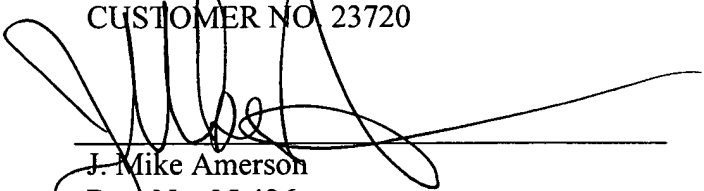
Independent claim 14 has been amended to recite that the landing feature comprises at least one shoulder formed on an inner surface of the keel guide. Such a structure is not disclosed or even suggested in the prior art of record. It is unclear to the undersigned if the device described in Davies could even be modified in such a manner as described by amended independent claim 14. What is clear is that there is simply no suggestion in the art of record to modify Davies in such a manner so as to arrive at Applicants’ invention. A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. It is respectfully submitted that any attempt to assert that the invention defined by independent claim 14 is obvious in view of the prior art of record constitutes an impermissible use of hindsight using Applicants’ disclosure as a roadmap. Accordingly, Applicants respectfully submit that claim 14, and all claims depending therefrom, are in condition for immediate allowance.

It view of the foregoing, it is respectfully submitted that all pending claims are in condition for immediate allowance. The Examiner is invited to contact the undersigned attorney at (713) 934-4055 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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